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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/995,358

11/26/2001

Jules Zecchino

2870/566

2755

7590 11/16/2007  
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EXAMINER

FUBARA, BLESSING M

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

11/16/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/995,358  | <b>Applicant(s)</b><br>ZECCHINO ET AL. |  |
|                              | <b>Examiner</b><br>Blessing M. Fubara | <b>Art Unit</b><br>1618                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-16 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-16 and 18-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Examiner acknowledges receipt of request for extension of time, request for reconsideration and remarks filed 9/06/07. Claims 1-10, 12-16 and 18-21 are pending.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 1-10, 12-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wheeler (WO 97/32559) in view of Clariant product brochure.

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Wheeler teaches the preparation of bi-liquid foam by combining oil-based biliquid foam and an aqueous gel, CARBOPOL gelling polymer and the pH is adjusted to 6.5 with citric acid (page 6, lines 1-10 and 20-23 and example 3).

Wheeler teaches cosmetic or pharmaceutical composition comprising a stable dispersion that comprises oil-based bi-liquid foam and an aqueous gel. The oil-based bi-liquid foam of Wheeler is from 1% to 80% by weight of the total formulation. The composition Of Wheeler also comprises silicone oils wherein the oils can be cyclomethicone, dimethicone, dimethicone copolyol, lanolin and dimethiconol. Wheeler teaches a formulation further comprising from 0.05% to 0.5% of surfactant and active ingredient in the aqueous or oily phase. Wheeler teaches that the low level of surfactant incorporated into the formulation comprises quaternary ammonium sulfonium salts, amphoteric surfactant, anionic surfactant, alpha-olefin sulfonate, and ester-linked sulfonate. Salts of cross-linked polymers of acrylic acid (carbomers), glyceryl polymethacrylates, or copolymers of polyoxyethylene/polyoxypropylene in mixtures with the previously listed surfactants may serve as gelling agents. Wheeler's composition (example 3) comprises Citric acid at 1% (Example 2) and the composition is adjusted to pH 6.5 (less than pH 7). See page 3, paragraph 2 to page 5 paragraph 2. The 1% of the hydroxyl acid in Example 2 meets the salt requirement in claims 1, 3-5.

Regarding the percent amounts of the gallant and the salt, it would be obvious to use appropriate amount of the gallant to effect the desired viscosity of the gelled composition. However, Wheeler does not use polymeric sulfonic acid as a gelling agent. However, Clariant product brochure teaches Aristoflex AVC or copolymer of polyacryldimethyltauramide and vinylformamide gelling agent for aqueous systems and thickening agent for oil-in-water

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emulsions. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare the bi-liquid foam by gelling the composition with CARBOMER polymer according to the teachings of Wheeler. One having ordinary skill in the art would have been motivated to substitute CARBOMER gelling agent with another gelling agent such as polyacryldimethyltauramide-co-vinylformamide (Aristoflex) with the expectation that the aqueous composition will be gelled.

#### ***Response to Arguments***

4. Applicant's arguments filed 9/06/07 have been fully considered but they are not persuasive.

Applicant argues that a) Wheeler does disclose or suggest use of polymeric sulfonic acid gallant and that Examples 2 and 3, which are the sole formulations disclosed as having a pH of less than 7, have a 20 weight% surfactant and the reference discloses that "shampoos and shower gels generally contain 4-18% by weight of a primary surfactant and 2-15% by weight of a coactive surfactant." b) The declarations by Matathia and Harrison "unequivocally demonstrate the superiority of the polymeric sulfonic acid in stably gelling the bi-liquid foam."

#### **Response:**

Regarding a), it is noted that the composition is the oil-containing bi-liquid foam and in that respect, Wheeler describes a bi-liquid foam that comprises oil and detergent/surfactant in amounts less than 1% (see page 7, lines 9-15 from the bottom) and this bi-liquid foam is used

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also in examples 2 and 3. Examples 2 and 3 are not the only compositions in Wheeler that has pH of less than 7. All three compositions are at a pH of less than 7. Example 1 is a skin cleansing composition and the total composition of the aqueous phase and the bi-liquid foam would have a total surfactant of 1.45 (0.95 + 0.5) in 200 g, which would be  $(1.45/200 \times 100) = 0.725$ , and this is less than 1%. Therefore, Wheeler teaches that cleansing composition can have less than 1% surfactant. Furthermore, the 4<sup>th</sup> paragraph of page 3 of the Wheeler reference states, "surfactant to stabilize the formulation may comprise between 0.05 and 0.5%, and preferably between 0.05 and 0.3%, which is less than 1%. This clearly shows/suggests that the percent surfactant is desired to be less than 1%.

The examiner agrees with applicant that Wheeler does not teach polymeric sulfonic acid and that is the difference between the Wheeler reference and the claims. The teaching of the Clariant product is relied upon for teaching the use of polymeric sulfonic acid as a gelling agent and one gelling agent can be used in place of the other and reasonably expect the formation of a gelled composition. Contrary to applicant's suggestion that substituting the polymeric sulfonic acid for another gelling agent would not result in applicant's claimed composition, it is noted that the goal is to make gelled composition and the use of the polymeric sulfonic acid would be expected to form gelled composition.

Regarding b), the examiner does not dispute applicant's assertion that the polymeric sulfonic acid is a superior gelling agent for the bi-liquid foam. The issue was that the declarations under 37 CFR 1.132 filed 11/01/2003 is insufficient to overcome the rejection of claims 1-10, 12-16 and 18-21 based upon Wheeler (WO 97/32559 as set forth in the Office action of 1/30/2004 and in the last Office action because: The declaration is not commensurate

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with the scope of the claims. Since the secondary reference teaches polymeric acid as a gellant, and since one gellant can be substituted for another, prediction or lack of prediction of the superiority of the polymeric sulfonic acid over the carbomer would not distinguish over the composition formed by substituting polymer sulfonic acid for carbomer since the same effect is obtained. Also, the declaration does not provide scientific data disproving the art recognized bi-liquid foam of Wheeler.

Examiner's response in the middle of page 5 of the last office action was addressing applicant's reference to the declarations by Matathia and Harrison. To the best of examiners knowledge, the 1.132 declarations by Matathia and Harrison were filed 11/01/2003 and there does not appear to be any other declarations by Matathia and Harrison. Thus, since the declarations are unchanged, they are not effective to place the claims in condition for allowance. The responses to those declarations remain the same as that given on 1/30/2004 because applicant appears not to consider the reliance of the Clariant product brochure as providing the polymeric sulfonic acid as a substitute for the Wheeler gelling agent just as the declarations ignored the reliance on the Clariant brochure's teaching of the polymeric sulfonic acid as a gelling agent that can be used in place of the Wheeler gelling agent.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blessing M. Fubara whose telephone number is (571) 272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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